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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICIAL
S. Ellis

In re Application of:

Kuriacose JOSEPH, et al.

Examiner: Kalinowski, Alexander G.

Application No.: 09/672,523

Art Group: 3626

Filed: September 27, 2000

For: A METHOD AND SYSTEM TO
FACILITATE ORDERING OF AN
ITEM (As Amended)I hereby certify that this correspondence is being
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450.**RESPONSE TO THE NOTICE OF NON-COMPLIANT AMENDMENT**
(37 CFR 1.121)

Sir:

In response to the Notice of Non-Compliant Amendment, mailed November 13, 2003, Applicants have below set forth the complete listing of all of the claims of the application.

Amendments to the Claims are reflected in the listing of claims that begins on page 2 of this paper.

Remarks/Arguments begin on page 13 of this paper.

Amendments to the Claims:

Please cancel claims 26 and 56, without prejudice.

Please amend the claims as follows:

1 - 9 (Cancelled)

10. (Currently Amended) A method of facilitating ordering an item using a distributed computing system including at least one client and at least one server, the method including:

receiving data, at the client, the data including information to at least one of show and describe the item via the client and an item identifier to enable the client to identify the item as currently being offered for sale;

at least one of showing and describing ~~an~~ the item to a user via the client

enabling the user to place an order for the item by a single action with respect to the client while the item is being offered for sale, the single action being in connection with the order; and

in response to the single action with respect to the client, causing ~~an~~ the order for the item to be placed,

wherein the enabling of the user to place the order for the item by the single action includes using (1) previously stored, user related personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) ~~previously received information related to the item identifier to enable the client to identify~~ the item as currently being offered for sale at the time of the single action.

11. (Previously Presented) The method of claim 10, wherein the single action is one of a group including:

selecting of a single button; and
pressing of a single button on a TV remote control.

12. (Canceled)

13. (Previously Presented) The method of claim 10, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.

14. (Previously Presented) The method of claim 10, wherein the user related, personal information is stored in memory in the client.

15. (Previously Presented) The method of claim 10, wherein the distributed computing system is an interactive television system and wherein the at least one of showing and describing of the item is, at least in part, by a television signal.

16. (Previously Presented) The method of claim 10, wherein the client includes an auxiliary data processor and a client computer.

17. (Currently Amended) The method of claim ~~12~~ 10, wherein the client is associated with at least a set top box, and wherein the user related, personal information is stored at the set top box.

18. (Previously Presented) The method of claim 17, wherein the set top box is in communication with a local computer and associated storage and wherein the method further includes:

the client retrieving information from one or more of the local computer and the associated storage.

19. (Previously Presented) The method of claim 18, wherein the method further includes: controlling the client by means of the local computer.
20. (Previously Presented) The method of claim 18, wherein the local computer is part of a local area network.
21. (Previously Presented) The method of claim 10, wherein the system further includes a central processing facility in communication with the server and wherein the method includes:
 sending information used in processing the order from the client to the central processing facility.
22. (Previously Presented) The method of claim 10, further including:
 sending an order confirmation to the user to confirm the order.
23. (Previously Presented) The method of claim 21, further including:
 communicating information between the client and the server via the central processing facility.
24. (Previously Presented) The method of claim 23, wherein a telephone system acts as the central processing facility.
25. (Currently Amended) The method of claim 10 including receiving at the client data including
 (a) ~~information to at least one of show and describe the item via the client;~~
 and
 (b) information to enable the user to order the item by the single action with respect to the client.
26. (Canceled)

27. (Currently Amended) The method of claim 26 10 wherein the item identifier includes at least one of a group of identifiers including a code and a command.

28. (Currently Amended) A method of facilitating ordering an item, the method including:

providing a client with information to at least one of show and describe an item to a user, and with an item identifier to identify the item as currently being offered for sale; and

enabling the user to place an order for the item by a single action with respect to the client, the single action being in connection with the order,

wherein the enabling of the user to place the order for the item by the single action includes using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed, and (2) ~~previously provided item information related to the item identifier information to identify the item that is~~ as currently being offered for sale at the time of the single action.

30. (Canceled)

29. (Currently Amended) The method of claim 28, wherein the single action includes a at least one of a group including:

selecting of a single button; and

pressing of a single button on a TV remote control.

31. (Previously Presented) The method of claim 28, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.

32. (Previously Presented) The method of claim 28, including retrieving the user related, personal information from a memory associated with the client.
33. (Previously Presented) The method of claim 28, including providing the information to at least one of show and describe the item in the form of a television signal.
34. (Previously Presented) The method of claim 28 including communicating with a central processing facility and wherein the client sends the order to the central processing facility for receipt via a transceiver.
35. (Previously Presented) The method of claim 34 wherein a telephone system acts as the central processing facility.
36. (Previously Presented) The method of claim 28 including providing an order confirmation to the client to confirm the order.
37. (Previously Presented) The method of claim 28 including multiplexing the provision of the information to at least one of show and describe the item and code to the client to thereby generate data for transmission to the client.
38. (Currently Amended) A computer system to order an item, the system including:
 a data receiver to receive data including information to at least one of
 show and describe the item, and an item identifier to identify the item as currently
 being offered for sale;
 a data processing system to at least one of show and describe an item to a user; and
 a client to enable the user to place an order for the item by a single action with respect to the client while the item is being offered for sale and, in response to the single action, to cause an the order for the item to be placed,

wherein the client is to enable the user to place the order for the item by the single action using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) ~~previously received information related to the item identifier~~ identifying the item that is as currently being offered for sale at the time of the single action.

39. (Previously Presented) The system of claim 38, wherein the single action includes at least one of a group including:

selecting of a single button; and
pressing of a single button on a TV remote control.

40. (Canceled)

41. (Previously Presented) The system of claim 38, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.

42. (Previously Presented) The system of claim 38, wherein the user related, personal information is stored in memory of the client.

43. (Previously Presented) The system of claim 38, wherein the computer system is an interactive television system and wherein the at least one of showing and describing of the item by the data processing system is, at least in part, performed utilizing a television signal.

44. (Canceled)

45. (Previously Presented) The system of claim 38, wherein the client is associated with at least a set top box, and wherein the user related, personal information is stored at the set top box.

46. (Previously Presented) The system of claim 45, wherein the set top box is in communication with a local computer and associated storage and wherein the client is to retrieve information from one or more of the local computer and the associated storage.

47. (Previously Presented) The system of claim 46, wherein the local computer controls the client.

48. (Previously Presented) The system of claim 46, wherein the local computer is part of a local area network.

49. (Previously Presented) The system of claim 38, including a central processing facility in communication with a server and wherein the client sends information used in processing to the central processing facility.

50. (Previously Presented) The system of claim 49 wherein the server is to send an order confirmation to the user to confirm the order.

51. (Previously Presented) The system of claim 49, wherein the central processing facility is to communicate information between the client and the server.

52. (Previously Presented) The system of claim 51 wherein a telephone system acts as the central processing facility.

53. (Currently Amended) The system of claim 38 ~~including a~~ wherein the data receiver is to receive the data including:

~~information to at least one of show and describe the item via the client;~~

and

information to enable the user to order the item by the single action with respect to the client.

54. (Previously Presented) The system of claim 53 wherein the data receiver includes an auxiliary data extractor to extract the information to at least one of show and describe from the data and a packet data extractor to extract the information to enable from the data.

55. (Previously Presented) The system of claim 54 wherein the auxiliary data extractor provides the information to at least one of show and describe to the data processing system and the packet data extractor provides the information to enable to the client.

56. (Canceled)

57. (Currently Amended) The system of claim ~~56~~ 38 wherein the item identifier includes at least one a group of identifiers including a code and a command.

58. (Currently Amended) A computer system to facilitate ordering an item, the system including:

a data source to provide a client with first information to at least one of show and describe an item to a user, and third information to identify the item as currently being offered for sale; and

an information source to provide the client with second information to enable the user to place an order for the item by a single action with respect to the client,

wherein the client is to enable the user to place the order for the item, while being offered for sale, by the single action using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) ~~previously received information related to~~ the third information identifying the item that is as currently being offered for sale at the time of the single action.

59. (Previously Presented) The system of claim 58, wherein the single action includes at least one of a group including:

a selecting of a single button; and

a pressing of a single button on a TV remote control.

60. (Canceled)

61. (Previously Presented) The system of claim 58, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.

62. (Previously Presented) The system of claim 58, wherein the second information includes code executable by the client to retrieve the user related, personal information from a memory associated with the client.

63. (Previously Presented) The system of claim 58, wherein the data source is to provide the information in the form of a television signal.

64. (Previously Presented) The system of claim 58 including a data transceiver to communicate with a central processing facility and wherein the client sends the order to the central processing facility for receipt via the data transceiver.

65. (Previously Presented) The system of claim 64 wherein a telephone system acts as the central processing facility.

66. (Previously Presented) The system of claim 58 wherein the data source is to provide an order confirmation to the client to confirm the order.

67. (Previously Presented) The system of claim 58 including a multiplexer to multiplex the provision of the first information to at least one of show and describe and

the second information to enable to the client to thereby generate data for transmission to the client.

68 - 245 (Canceled)

246. (Previously Presented) The method of claim 25 wherein the information to enable includes code executable by the client to enable the user to order the item by the single action with the client.

247. (Previously Presented) The method of claim 25 wherein the information to enable includes data to be processed by code executable by the client to enable the user to order the item by the single action with the client.

248. (Previously Presented) The method of claim 28 wherein the enabling includes providing code to enable the user to order the item.

249. (Previously Presented) The method of claim 28 wherein the enabling includes providing data to be processed by code to enable the user to order the item.

250. (Previously Presented) The system of claim 53 wherein the information to enable includes code to enable the user to order the item.

251. (Previously Presented) The system of claim 53 wherein the information to enable includes data to be processed by code to enable the user to order the item.

252. (Previously Presented) The system of claim 58 wherein the second information to enable includes code to be executed by the client to enable the user to order the item.

253. (Previously Presented) The system of claim 58 wherein the information to enable includes data to be processed by code to enable the user to order the item.

254 - 259 (Canceled)

260. (Currently Amended) A machine-readable medium embodying a sequence of instructions that, when executed by a machine, cause the machine to facilitate ordering an item within a distributed computing system including at least one client and at least one server by:

receiving data, at the client, the data including information to at least one of show and describe the item via the client and an item identifier to enable the client to identify the item as currently being offered for sale;

at least one of showing and describing ~~an~~ the item to a user via the client;
enabling the user to place an order for the item by a single action with respect to the client while the item is being offered for sale, the single action being in connection with the order,

in response to the single action with respect to the client, causing ~~an~~ the order for the item to be placed,

wherein the enabling of the user to order the item by the single action includes using (1) previously stored, user related, personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) ~~previously received information related to the~~ item identifier to enable the client to identify the item that is as currently being offered for sale at the time of the single action.

261. (Previously Presented) The machine-readable medium of claim 260, wherein the medium includes a data stream.

262. (Previously Presented) The machine-readable medium of claim 260, wherein the medium includes a mass storage device.

263. (Currently Amended) A machine-readable medium embodying a sequence of instructions that, when executed by a machine, cause the machine to facilitate ordering an item by:

providing a client with information to at least one of show and describe an item to a user, and with an item identifier to identify the item as currently being offered for sale; and

enabling the user to place an order for the item by a single action with respect to the client, the single action being in connection with the order,

wherein the enabling of the user to place the order for the item by the single action includes using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed, and (2) previously provided item information related to the item identifier information to identify the item that is as currently being offered for sale at the time of the single action.

264 - 357 (Canceled)

REMARKS**1. Summary of the Office Action**

Claims 10, 11, 13-29, 31-39, 41-43, 45-59, 61-67, 246-253, and 260-263 stand rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

Claim 17 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

Further, claims 10, 12, 15, 16, 21-26, 28, 33-36, 38, 40, 43, 51-54, 58, 60, 63-66, 260, 262, and 263 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over US Patent No. 5,621,456 (hereinafter Florin) in view of US Patent No. 4,734,858 (hereinafter Schlafly).

Further, claims 11, 29, 39, and 59 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Florin and Schlafly, as applied to claims 10, 28, 38 and 58, and further in view of Zachary et al, "Technology: HP is building Gadget to Make TVs Interactive" (hereinafter Zachary).

Claims 13, 14, 17, 31, 32, 41, 42, 45, 61, and 62 also stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Florin and Schlafly, as applied to claims 10, 28, 38 and 58, and further in view of US Patent No. 4,163,255 (hereinafter Pires).

Claim 27 also stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over Florin and Schlafly, as applied to claim 26, and further in view of U.S. Patent No. 4,965,825 (hereinafter Harvey.).

Claims 18-20 and 46-48 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Florin and Schlafly, as applied to claims 10 and 38, and further in view of US Patent No. 4,789,895 (hereinafter Mustafa).

2. Response to § 251 Rejection

The Applicants respectfully disagree that the claims identified under this rejection constitute "an improper recapture of broadened claimed subject matter surrendered in the application for the patent on which the present reissue is based" (Office Action, page 2). The Applicants respectfully disagree that any broadening aspects of the reissue claims are related to subject matter that the Applicants previously surrendered, during the prosecution of U.S. Patent No. 5,819,034 (the '034 patent). The Applicant's reasons in connection with this position are set out more fully below.

A failure of a patentee (or a patentee's attorney) to appreciate the full scope of the invention during the prosecution of the original patent application is well recognized as an error correctable by a broadening reissue. See Amos, 953 F.2d at 616, 21 USPQ2d at 1273; In re Wilder, 736 F.2d 1516, 1519, 222 USPQ 369, 371 (Fed. Cir. 1984). This form of error has generally been accepted as sufficient to satisfy the "error" requirement of § 251. See Clement, 131 F.3d at 1468, 45 USPQ2d at 1163; Wilder, 736 F.2d at 1519, 222 USPQ at 371.

Broadening reissues are subject to the "recapture rule", which is discussed in Clement, 131 F.3d at 1468, 45 USPQ2d at 1164. The recapture rule "prevents a patentee from regaining through reissue . . . subject matter that he surrendered in an effort to obtain allowance of the original claims." Clement, 131 F.3d at 1468, 45 USPQ2d at 1164. The rule is rooted in the "error" requirement in that such a surrender is not the type of correctable "error" contemplated by the reissue statute. See Mentor, 998 F.2d at 995-96, 27 USPQ2d at 1525.

The Federal Circuit, in Clement, 131, F. 3d 1464, 1468-70, 45 USPQ2 at 1161, 1163-65 (Fed. Cir. 1997), stated that an analysis under the recapture rule includes a four-step analysis, namely:

1. Determining whether and in what "aspects" the reissue claims are broader than the claims of the issued patent. A reissue claim that does not include a limitation present in the original patent claims is broader in that respect. See id.
2. Determining whether the broader aspects of the reissue claims relate to surrendered subject matter. "To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection." See id. at 1469, 45 USPQ2d at 1164.
3. Determining whether the surrendered subject matter has "crept" into the reissue claims.
4. Determining whether the reissue claims are materially narrowed, relative to the claims of the issued patent, in other respects, with a view to determining whether the recapture may be avoided. For example, in Ball Corp. v. United States, the recapture rule was avoided because the reissue claims were sufficiently narrowed (described by the court as "fundamental narrowness") despite the broadened aspects of the claims. 729 F.2d at 1438, 221 USPQ at 296.

Applying the above discussed analysis under the recapture rule to the claims of the present reissue application, it is apparent that the reissue claims are broader than the issued claims of the '034 patent in certain aspects, but also narrower relative to the issued

claims in other respects. Specifically the claims of the present reissue application are directed to facilitating ordering an item using a distributed computer system. Accordingly, limitations of at least the independent claims of the present reissue application are absent from the independent claims of the '034 patent. Consider, for example, the first limitation of independent claim one of the '034 patent, which requires the following:

A source of a data stream providing a series of time division multiplexed packets, ones of which contain auxiliary data that represent a video program, and others of which represent a distributed computing application associated with said video program, and wherein said distributed computing application is repetitively transmitted independent of receiving client computer apparatus during times that said video program is transmitted. ('034 patent, column 14, lines 37-45).

Clearly, claim 10 of the present reissue application does not include a limitation corresponding to the above-identified limitation of claim 1 of the '034 patent, and claim 10 of the present reissue application is accordingly broader in this respect.

On the other hand, consider the following limitation of claim 10 of the reissue claims:

Enabling the user to place an order for the item with a single action with respect to the client, while the item is being offered for sale, the single action being in connection with the order.

The issued claims of the '034 patent do not include a limitation corresponding to the above-identified limitation of claim 10 of the reissue application. In this respect, claim 10 of the reissued claims has been materially narrowed, relative to the claims of the '034 patent. The Applicants believe that this constitutes what is identified as a

"fundamental narrowness", identified in Ball Corp., which avoids the recapture rule, despite broadened aspects of the claims.

Further, as limitations of the issued claims of the '034 patent are not present in the reissue claims, the Applicants believe that the broader aspects of the reissue claims (i.e., the aspects corresponding to limitations in the '034 patent that are absent in the independent claims of the current reissue application) do not relate to surrendered subject matter. This is because the Applicants could not, by way of argument or amendment, surrender subject matter corresponding to the limitations of the present reissue claims in view of the absence of these limitations from the issued claims of the '034 patent. Consider for example that the claims of the '034 patent do not include any limitations directed to enabling "the user to place an order for an item by a single action." Accordingly, the opportunity did not arise during the prosecution of the '034 patent for the Applicants to in fact surrender subject matter pertaining to this limitation. In short, the subject matter of the independent claims of the current reissue application is different from the subject matter of the issue claims of the '034 patent, and the question of recaptured subject matter does not arise. This dovetails with the above position that the reissue claims are sufficiently narrowed, despite the broadened aspects of the claims, so as to avoid the recapture rule.

In conclusion, the Applicants believe that the rejection under 35 U.S.C. § 251 has been fully addressed, and withdrawal of this rejection is requested.

The Applicants note that the Office Action states that "[a]t a minimum, the claims require at least one of the following limitations which were argued as the patentable feature for the issued independent claims 1, 6, 7, and 9 in the 08/233,098 application", whereafter the limitations of the identified independent claims are listed (Office Action, pages 3-5). The Applicants fail to fully understand the reason for this alleged requirement. The Applicants also draw the Examiner's attention to the co-pending divisional reissue application serial number 09/903,458, in which claims corresponding to the issued claims of the '034 patent are presented. It will be recalled that, on the

suggestion of the Examiner, a number of divisional reissue applications were filed based off the current reissue application, each of these divisional applications including claims that were originally included in the current reissue application. Claims corresponding to the claims of the divisional reissue applications were then cancelled from the current reissue application, by way of a preliminary amendment dated April 13, 2001.

By requiring that a limitation in the claims of the '034 be present in the claims of the present reissue application, we speculate that reference is being made to the "original invention" requirement. We below quote the pertinent section (1412.01) from the MPEP:

1412.01 Reissue Claims Must Be for Same General Invention

The reissue claims must be for the same invention as that disclosed as being the invention in the original patent, as required by 35 U.S.C. 251. This does *not* mean that the invention claimed in the reissue must have been claimed in the original patent, although this is evidence that applicants considered it their invention. The entire disclosure, not just the claim(s), is considered in determining what the patentee objectively intended as his or her invention. The proper test as to whether reissue claims are for the same invention as that disclosed as being the invention in the original patent is "an essentially factual inquiry confined to the objective intent manifested by the **original patent**." *In re Amos*, 953 F.2d 613, 618, 21 USPQ2d 1271, 1274 (Fed. Cir. 1991) (quoting *In re Rowand*, 526 F.2d 558, 560, 187 USPQ 487, 489 (CCPA 1975)) (emphasis added). See also *In re Mead*, 581 F.2d 257, 198 USPQ 412 (CCPA 1978). The "original patent" requirement of 35 U.S.C. 251 must be understood in light of *In re Amos, supra*, where the Court of Appeals for the Federal Circuit stated:

We conclude that, under both *Mead* and *Rowand*, a claim submitted in reissue may be rejected under the "original patent" clause if

the original specification demonstrates, to one skilled in the art, an absence of disclosure sufficient to indicate that a patentee could have claimed the subject matter. Merely finding that the subject matter was "not originally claimed, not an object of the original patent, and not depicted in the drawing," does not answer the essential inquiry under the "original patent" clause of § 251, which is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees. In short, the absence of an "intent," even if objectively evident from the earlier claims, the drawings, or the original objects of the invention is simply not enough to establish that the new claims are not drawn to the invention disclosed in the original patent.

953 F.2d at 618-19, 21 USPQ2d at 1275. Claims presented in a reissue application are considered to satisfy the requirement of 35 U.S.C. 251 that the claims be "for the invention disclosed in the original patent" where:

(A) the claims presented in the reissue application are described in the original patent specification and enabled by the original patent specification such that 35 U.S.C. 112 first paragraph is satisfied; and

(B) nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application.

(MPEP 1412.01, Emphasis Added)

The claims of the present reissue application are clearly described in the original patent specification for the '034 patent, and are likewise enabled by the original patent specification for the '034 patent, such that 35 U.S.C. § 112, first paragraph, is satisfied.

Further, there is nothing in the original patent specification for the '034 patent which indicates an intent not to claim the subject matter of the claims of the present reissue application.

In short, the Applicants do not believe that a limitation from the issued independent claims of the '034 patent is required within the independent claims of the present reissue application in order to satisfy the "original invention" requirement.

3. **Response to § 112 Rejection**

Claim 17 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

The Examiner is thanked for identifying this error in the dependency of claim 17. The Applicants have amended claim 17 to be dependent upon claim 10, as correctly assumed by the Examiner.

4. **Response to § 103 Rejections**

The Applicants respectfully traverse these rejections for the reasons set out below, and ask the Examiner for reconsideration. The Applicants have further also slightly amended the claims to define clearly the intended import of the claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

**THE PRIOR ART REFERENCES DO NOT TEACH OR SUGGEST ALL CLAIM
LIMITATIONS, WHEN CONSIDERED SINGULARLY OR IN COMBINATION.**

Taking claim 10 of the present reissue application as an exemplary claim for discussion purposes, the Office Action contends that "Florin does not explicitly disclose:

order the item by a single action with the client; and

wherein the enabling of the user to order the item by a single action includes 1) previously stored user related personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related personal information each time a further order is placed and 2) previously received information related to the item being offered for sale at the time of the single action." (Office Action, page 6-7)

The Office Action then goes on to state that Schlafly discloses ordering of the item by a single action with the user, and points to the disclosures in Schlafly, quoted immediately below, in support of this position:

Once the item has been specified it can be reviewed and modified or it can be stored in a send memory at 92 and later caused to be sent at 94 by automatic dialing of the local processor center 14. Once communication has been established, the entire content of the send memory is transmitted in a burst by

actuation of an internal modem (modulator/demodulator) 96 and the local center commences processing at 98. The send data is initially checked at 98 for verification of some of the data and a return is transmitted the data terminal at 100. The connection is then broken by the LPC and at 102 and the terminal goes "on hook". The message represented by the return is displayed at 104.

(Schlafly, column 7, lines 35-47).

However, immediately preceding the above-quoted disclosure in Schlafly, the below disclosure is provided regarding actions that are required by a user:

Operation of a data terminal 12 in the case of ordering of merchandise from various mail order suppliers is illustrated with FIGS. 3-6. FIG. 4 shows a portion 80 of a page from a Sears catalog. FIG. 5 illustrates a portion 82 of a J.C. Penney Catalog page.

As an example of a catalog order data entry, at 84 in FIG. 3 and after turn on, the user's individual subscriber secret personal authorization number, a four digit number for example, promptly by a word display, is entered. This is followed by sequentially occurring prompts, which permit entry of additional order key actuations in accordance with suitable accompanying operating instructions.

The first set of prompts at 86 calls for the entry of a code specifying the supplier by its catalog and a page number. The second set of prompts at 88 requires specification of the nature of the transaction, e.g. catalog number and special charge and shipping instructions if required. The third set of prompts at 90

requires entry of the quantity and options such as color and size when these are needed to properly specify the desired item.

(Schlafly, column 7, lines 13-34).

Clearly, the ordering of an item, as disclosed in Schlafly, requires more than a single action with respect to the client. Specifically, to perform a catalogue order utilizing the system and methodology disclosed in Schlafly, a user is required to provide an individual subscriber secret personal authorization number, which is followed by sequentially occurring prompts responsive to which the user enters a code specifying a supplier by a catalogue and page number, the nature of the transaction, and the quantity and options pertaining to the relevant order.

In short, Schlafly simply does not disclose placing an order for an item by a single action with respect to a client, but instead clearly discloses a sequence of actions. Schlafly is accordingly cumulative with the disclosures provided in Florin.

Claim 1, as indicated above, has also been amended to include a limitation corresponding substantially to limitations of claims 25 and 26, claim 26 now having been cancelled. Specifically, claim 10 now recites the receiving of data at the client, the data including information to at least one of show and describe the item via the client, and an item identifier to enable the client to identify the item as currently being offered for sale. Claim 10 has also now been amended to recite that the enabling of the user to place the order for the item via the single action includes utilizing the received item identifier.

The above remarks also address the further rejections presented under 35 U.S.C. §103 against the other claims of the present reissue application. Specifically, the further independent claims each include limitations corresponding approximately to those of claim 10. The dependent claims are deemed to include all limitations of claims from which they depend, and the above remarks similarly address the rejections presented under 35 U.S.C. §103 against these dependent claims.

In light of the above, the Applicants respectfully submit that the rejections under 35 U.S.C. § 103 have been overcome, and withdrawal of these rejections is therefore respectfully requested.

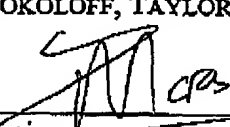
5. Conclusion

Having tendered the above remarks, and amended the claims as indicated herein, the Applicants respectfully submit that all rejections have been addressed and that the claims are now in a condition for allowance, which is earnestly solicited.

If there are any additional charges, please charge Deposit Account No. 02-2666. If a telephone interview would in any way expedite the prosecution of the present application, the Examiner is invited to contact André Marais at (408) 947-8200 ext. 204.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 12/15/ 2003



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☐ Other

PAGE 1/27 * RCVD AT 12/15/2003 8:27:44 PM [Eastern Standard Time] * SVR:USPTO-EFEXRF-2/1 * DNIS:7468000 * CSID:4089478280 * DURATION (mm:ss):06:10

FEE TRANSMITTAL for FY 2003

Effective 01/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27.

TOTAL AMOUNT OF PAYMENT (\$)

Complete if Known

Application Number	09/672,523
Filing Date	September 27, 2000
First Named Inventor	Kuriacose Joseph
Examiner Name	Alexander G. Kalinowski
Group/Art Unit	3621
Attorney Docket No.	5214P001R

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None
☒ Deposit Account

Deposit Account Number: 02-2666

Deposit Account Name: Blakely, Sokoloff, Taylor & Zafman LLP

The Commissioner is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments
☒ Charge any additional fee(s) required under 37 CFR §§ 1.16, 1.17, 1.18 and 1.20.
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account

FEE CALCULATION

BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(5)

2. EXTRA CLAIM FEES

Total Claims: 65 = 65 X 3 = 195 = Fee Paid

Independent Claims: 3 = 3 X 3 = 9 = Fee Paid

Multiple Dependent: 0 = 0 X 3 = 0 = Fee Paid

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	18	2202	9	Claims in excess of 20	
1201	86	2201	43	Independent claims in excess of 3	
1203	290	2203	145	Multiple Dependent claim, if not paid	
1204	86	2204	43	Reissue independent claims over original patent	
1205	18	2205	9	Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2)					(5)

*or number previously paid, if greater, For Reissues, see below

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	180	2051	85	Surcharge - late filing fee or oath	
1052	80	2052	25	Surcharge - late provisional filing fee or cover sheet	
2063	130	2053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920 *	1804	920 *	Requesting publication of SIR prior to Examiner action	
1805	1,840 *	1805	1,840 *	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	650	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	1,210	2255	605	Extension for reply within fifth month	
1404	330	2404	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	2451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	2460	130	Petitions to the Commissioner	
1907	50	1907	50	Processing fee under 37 CFR 1.17(a)	
1806	180	1806	180	Submission of Information Disclosure Sheet	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1808	770	1808	385	Filing a submission after final rejection (37 CFR § 1.123(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.123(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	
Other fee (specify)					
SUBTOTAL (3)					(5)

* Reduced by Basic Filing Fee Paid

SUBMITTED BY

Name (Print/Type)	André L. Marais	Registration No. (Attorney/Agent)	48,095	Telephone	(408) 947-8200
Signature		Date	12/15/03		

Based on PTO/SB/17 (08-03) as modified by Blakely, Sokoloff, Taylor & Zafman (M) 09/11/2003.
 SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450